

Notice of Allowability

Application No.

10/767,779

Applicant(s)

LEAMON ET AL.

Examiner

Samuel Woolwine

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendments filed 7/3/2007.
2. ☒ The allowed claim(s) is/are 1-7,9 and 73-75.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

/Young J. Kim/
Primary Examiner
Technology Center 1600

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In the Claims:

In claim 5, change "©" to "(c)".

Response to Amendment

In response to Applicant's amendment filed 3/30/2007, it is noted that currently amended claim 1 is found to be supported by pages 46-50 of provisional application 60/465,071. An earlier Office action (OA 01/10/2007) indicated that this provisional application did not support delivering a single bead to a single reaction chamber (page 38 of OA). However, upon closer inspection, support for this limitation is found on page 46, 2nd paragraph, of 60/465,071.

Drawings

These replacement drawings submitted on 9/22/2004 are acceptable.

Double Patenting

The double patenting rejection made in the previous Office action (07/03/2007) is withdrawn. The current claims of co-pending applications 10/767,899 and 10/767,894 are drawn to methods of attaching nucleic acid molecules to beads using a water-in-oil emulsion, which corresponds to steps b and c of instant claim 1. However, the claims of

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the '899 and '894 applications are more specific in the means by which this attachment is carried out. In this respect, the claims of the instant application are regarded as the "base" invention, while the current claims of the '899 and '894 applications are deemed to represent the "improvement". Since all three applications have the same effective filing date, the double patenting rejection over the instant claims is withdrawn in accordance with MPEP 804(I)(B)(1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2005/0037392 A1 (US application 10/866,237) discloses a method for amplifying nucleic acid and capturing the amplified product on a bead within a droplet of an emulsion (see claims). In order to rely on this disclosure as a prior art teaching under 35 U.S.C. §102(e), the earlier filed application to which priority is claimed must support the subject matter relied upon under 35 U.S.C. §112, 1st paragraph (see MPEP 706.02(f)(1)(I)(B)). A review of the priority document (USPN 6,808,882) fails to find support for the claims of US 2005/0037392 A1, and therefore cannot be relied upon to support a rejection of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Woolwine whose telephone number is (571) 272-1144. The examiner can normally be reached on Mon-Fri 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SCW

/Young J. Kim/
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